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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,620	08/18/2000	John David Westwood	SJ0000003US1	8250

7590

03/27/2003

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

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DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,620

Applicant(s)

WESTWOOD, JOHN DAVID

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) 4-23 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-3 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s) _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Amendments to claim 1, filed on January 30, 2003, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. ('016) in view of Kenji et al. ('219 A) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on October 23, 2002 (Paper No. 4).
4. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al. ('297) in view of Kenji et al. ('219 A) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on October 23, 2002 (Paper No. 4).

Response to Arguments

5. The rejection of claims 1 - 3 under 35 U.S.C § 103(a) – Sasaki et al. in view of Kenji et al.

The rejection of claims 1 - 3 under 35 U.S.C § 103(a) – Shimada et al. in view of Kenji et al.

Applicant(s) argue(s) that the references fail to establish a *prima facie* of obviousness since the references fail to suggest the desirability of the claimed invention. The examiner respectfully disagrees.

An invention may be obvious if the prior art has different reasons for doing what the applicant has done. "It has long been held that a rejection under 35 USC 103 based upon a combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention." *Ex parte Raychem Corp.* 17 USPQ 2d 1417, 1424 (BPAI 1990). Cites *In re Kronig* 190 USPQ 425 (CCPA 1976); *In re Gershon* 152 USPQ 602 (CCPA 1967). See also *In re Beattie* 24 USPQ 2d 1040, 1042 (Fed. Cir. 1992); *In re Wiseman* 201 USPQ 638 (CCPA 1979); *In re May* 197 USPQ 601 (CCPA 1978); *In re Lintner* 173 USPQ 560, 562 (CCPA 1972); *In re Tomlinson* 150 USPQ 623 (CCPA 1966); and *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

Applicants further argue that the references fail to teach or suggest all the claimed limitations, specifically that the limitation "nanolamination" requires a discontinuous layer, as per the specification. The examiner respectfully disagrees.

The examiner notes that the specification is not the measure of the invention. Therefore, limitations contained therein cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). The examiner notes that the specification has a broad definition for nanolamination and merely defines applicants layers as "[n]anolaminations of the present invention are

distinguished from conventional laminating layers in the prior art by their degree of thinness" (*specification, page 3, lines 14 – 15*). The present claims, therefore, are not limited to discontinuous layers.

Finally, applicants argue that neither Sasaki et al. nor Shimada et al. teach a thickness meeting applicants claimed limitations. The examiner respectfully disagrees.

First, with regard to the general teaching in Sasaki et al., the examiner notes that the teaching must be viewed as filtered through the mind of one of ordinary skill in the art. The phrase "a thickness equal to or more than Angstroms" is deemed to clearly imply a range of thickness from 1 Å or more. Second, with regard to the showing in Shimada et al. regarding the effect of thickness on coercivity, the examiner notes that Shimada et al. explicitly states that the thickness is "preferably 100 Å or less" (*col. 8, lines 19 – 20*), which corresponds to a coercivity of ~0.33 Oe or less (*Figure 5*). The examiner notes that even in the range where applicants state that the coercivity "increases", the value is still below the preferred value of 0.33, hence still meeting Shimada et al.'s preferred range. Finally, the examiner notes that the thickness was stated to be a cause effective variable (*see rejections of record – Paragraphs 7 and 8*), and the examiner has cited pertinent prior art supporting this position (*Paragraph 9 of the Office Action mailed October 23, 2002, Paper No. 4*).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
March 26, 2003



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700